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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/243,016	02/02/99	LENZ	

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HM12/0120  
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TARRYTOWN NY 10591-5144

EXAMINER
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GHALI, I	
ART UNIT	PAPER NUMBER

1615

DATE MAILED:

01/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/243,016

Applicant(s)

Lenz et al.

Examiner

Isis Ghali

Group Art Unit  
1615



☒ Responsive to communication(s) filed on Feb 2, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-13

\_\_\_\_\_ is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### DETAILED ACTION

Receipt of applicants preliminary amendment and priority paper, both filed 02/02/1999, and CFR, filed 03/25/1999, is acknowledged.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 6, 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claim 5, the applicants need to clarify what the following abbreviations are standing for : PU, PP, PE or PVC.

Claim 6 recites the limitation "polyesterurethane" in claim 5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, is broad and the parenthesis need to be deleted and the claim can be amended as "two-dimensional textile structure selected from the group consisting of nonwoven, knit or woven fabric".

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Claim 13 recites the limitation "process of producing" in 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 13, the claim is indefinite as it fails to further limit claim 1.

Regarding claim 13, step (a), the phrase "if present" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 13, step (f), the claim is confusing. The applicants need to clarify which layer to be coated.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel et al. (USPT.4,793,003), in view Kenndoff et al. (USPT.5,844,013), further in view of Martz (WO 89/01345) and Kohn et al. (USPT.4,709,695).

Riedel et al. are disclosing a light-occlusive self adherent eye patch comprising an absorbent pad having a nonadherent lower surface, a thin microporous polymeric film overlying the upper surface of the pad extending beyond the periphery of the absorbent pad, a pressure sensitive adhesive means extending around the periphery of the pad to adhere the patch to the eye socket, and a removable liner protecting the lower surface of the pad and the adhesive prior to use. The polymeric film block at least 95 % of the light. The microporous film is made of high density porous polyethylene. The absorbent pad and the polymeric film are bonded to the surface of a nonwoven web. The light occlusivity can be obtained by adding suitable non-toxic dyes or pigments to the polymer matrix or by coating one side of the film with a light absorbing paint or dye. The polyethylene film is relatively thin with thickness range from about 0.001 to 0.008 inch. The reference is also teaching porous polyurethane as an example of the microporous film. (See the abstract; col.2, lines 19-28, lines 38-42, lines 57-59; col.3, lines 61-65; col.4, lines 7-10, lines 15-24). However, the reference differs from the claimed invention because it does not teach more than foam layer, the density of the foamed material, the filler or a process of producing the occlusive patch.

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Kenndoff et al. are teaching a wound dressings such as wound plasters and adhesive plasters comprising a polyurethane film as a backing and a polyurethane gel foam together with a filler such as chalk or kaolin and also it is possible to use dyes or colored pigments to confer the required colors. The reference also disclosing a process of producing polyurethane foams including combining and mixing together the polyurethane, the foaming agent and filler and then foaming by stirring or beating in air and then spread the mix out to a sheet like structure. The thickness of the polyurethane foam layer can be 0.1 to 1.0 mm. and has a density of 0.25 0.75 g/square cm. The foam according to this reference can be applied to sheet like backing which is preferably provided with a polyurethane gel foam layer. (See col.4, lines 18-19, lines 39-40, lines 60-61; col.6, lines 46-59; col.16, lines 25-50; col.17, lines 11-13, lines 61-65; col.18, lines 38-45).

Martz is teaching a surgical dressing constructing of a thin elastomeric transparent film made of polyurethane or polypropylene having a thickness in a range of 0.5-10 mm. and is protected by a layer of nonwoven which has a structure of three dimensional entanglement of polyurethane. Adhesive is used in the dressing and if desired foam or other absorptive pad on the adhesive side of the film and a release sheet cover the adhesive layer. (See the abstract; page 4, lines 2-6, lines 10-11, lines 21-23; page 5, lines 9-14; page 13, lines 9-16; page 15, lines 9-10).

Kohn et al. are teaching a protective including an adhesive base of polyethylene which is adhesively attachable to patient's skin and to which a various protective coverings may be coupled and repeatedly decoupled and recoupled and it can be employed for transparent and opaque eye patches. (See the abstract; col.3, lines 8-22; col.4, lines 6-11).

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Accordingly, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine all the said forth teachings to produce an occlusive plaster consisting of at least one layer of foam material which is provided with adhesive on its lower layer with reasonable expectation of success of the delivered occlusive plaster. While Riedel been concerned about the thickness and softness of the eye patches and of making them comfortable to wear (col.2, lines 11-15), one with ordinary skill in the art would have been motivated to produce a patch from foam material.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPT.4,944,040, teaching light occlusive self adherent eye patch.

USPT.5,191,897, teaching a self adherent eye occluder.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Isis Ghali whose telephone number is (703) 305-4048. The examiner can normally be reached on Monday-Friday from 8:30 to 5:30 Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-3592.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Examiner Isis Ghali,

January 12, 2000.

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600